1. **Summary of Office Action**

In the office action mailed July 9, 2004, the Examiner objected to claim 6 because of the informal use of the acronym "PRL." Further, the Examiner rejected claims 1-10 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,549,770 (Marran).

2. **Amendments and Pending Claims**

The application as filed contained 10 claims. Applicants have amended claims 1, 8 and 10 and have added new claims 11-18. Thus, claims 1-18 are presently pending in this application, of which claims 1, 8, and 10 are independent, and the remainder are dependent. No new matter was added.

3. **The Claimed Invention**

Applicants' invention is directed to a method and system for forming priority data structures. Priority data structures include transmission rules that specify the circumstances under which a data download may be transmitted to a mobile wireless unit by a network logic server. The transmission rules within a priority data structure allow the network logic server to transmit the data to a mobile wireless device without the need for human intervention.

In this regard, many of the pending claims recite (or require by dependency) that a processing module is programmed to format at least one transmission rule into at least one priority data structure. For instance, independent claim 1 and its associated dependent claims 2-7 include this limitation.

Further, other pending claims recite (or require by dependency) establishing in a data storage medium at least one priority data structure that defines at least one transmission rule.

See independent claims 8 and 10 (as well as their associated dependent claims 9, and 11-18) for this limitation.

Further still, each of the independent claims 1, 8, and 10 specifically recites that the at least one priority data structure comprises a table selected from the group consisting of: (i) a priority mapping table, (ii) an off-peak setting table, and (iii) a resource allocation table. Applicants' specification provides examples of each of these tables.

For instance, an example of a priority mapping table is a table having (i) a priority column, (ii) an off-peak attempts column, (iii) a peak attempts column, and (iv) a plurality of rows. Each row defines a transmission rule. Each row includes (i) an assigned priority, (ii) the number of attempts to download data during off-peak hours, and (iii) the number of attempts to download data during peak hours.

An example of an off-peak setting table is a table having (i) a day-of-week column, (ii) an off-peak start column, (iii) an off-peak end-time column, and (iv) seven rows. Each row defines a transmission rule. Each row corresponds to (i) a day of the week, (ii) a specified off-peak starting time, and (iii) a specified off-peak ending time.

An example of a resource allocation table is a table having (i) a priority column, (ii) a resource allocation percentage column, and (iii) a plurality of rows. Each row defines a transmission rule. Each row includes a resource allocation percentage assigned to data downloads having a certain priority.

4.   Response to § 102 Rejections

As noted above, the Examiner rejected claims 1-10 under 35 U.S.C. § 102(e) as being anticipated by Marran.   Under M.P.E.P. § 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Applicants respectfully traverse the anticipation rejection of pending claims 1-10 because Marran does not disclose or suggest each and every element as recited in any of these claims.

Marran discloses a system and method for over the air (OTA) programming of mobile digital devices. *See Marran* at abstract. An OTA application server, a provisioning database, an expert system, interworking function (IWF) equipment, and an IP network, are used to perform the OTA programming. *Id.* at column 8, lines 29-37. The expert system combines a working memory with logic programming and a set of predetermined rules to trigger different programming actions. *Id.* at column 9, lines 8-11. The expert system initiates commands to which the IWF equipment responsively initiates dial-out type procedures to download programming data from the OTA application server to a particular digital device. *Id.* at column 10, lines 12-16.

However, Applicants do not find in Marran the specific elements recited in any of claims 3, 4, and 5. In particular, Applicants do not find in Marran the elements of (i) a priority data structure that comprises a priority mapping table, as recited in claim 3, (ii) a priority data structure that comprises an off-peak setting table, as recited in claim 4, or (iii) a priority data structure that comprises a resource allocation table, as recited in claim 5.

Marran teaches that the expert system consists of a set of rules, a set of facts, and a logical engine to reach conclusions drawn from the facts based on the rules, and that the expert

system accesses a data table through provisioning data. However, Marran does not disclose or suggest that (i) the provisioning data is a priority data structure that includes the data table, or (ii) the data table is a priority mapping table, an off-peak setting table, or a resource allocation table as defined by the Applicants. At best, Marran merely teaches storing a record of all digital telephones served through a network and the services that are currently provided to each digital telephone. Thus, Marran necessarily fails to teach Applicants' claimed (i) priority data structure that comprises a priority mapping table, (ii) priority data structure that comprises an off-peak setting table, and (iii) priority data structure that comprises a resource allocation table, as recited in claims 3, 4, and 5 respectively.

Because Marran does not teach or suggest all of the elements in claims 3, 4, or 5, Marran fails to anticipate these claims under § 102.

With respect to independent claims 1, 8, and 10, these claims were amended to recite the limitation wherein the at least one priority data structure comprises a table selected from the group consisting of: (i) a priority mapping table, (ii) an off-peak setting table, and (iii) a resource allocation table. The claim limitation added to claims 1, 8, and 10 includes elements of claims 3, 4, and 5, as to which the Examiner has already performed a search.

Further, as noted above, Marran does not disclose or suggest (i) a priority data structure that comprises a priority mapping table, (ii) a priority data structure that comprises an off-peak setting table, or (iii) a priority data structure that comprises a resource allocation table. Thus, Marran necessarily fails to teach the at least one priority data structure that comprises a table selected from the group consisting of: (i) a priority mapping table, (ii) an off-peak setting table, and (iii) a resource allocation table, as claimed in claims 1, 8, and 10.

Because Marran does not teach or suggest all of the elements in claims 1, 8, or 10, Marran fails to anticipate these claims under § 102. Further, because each of claims 2, 6, 7, 9, and 11-18 depend from claim 1, 8, or 10, Marran necessarily also fails to anticipate claims 2, 6, 7, 9, and 11-18 as well.

5. Response to Claim Objection

As noted above, the Examiner objected to claim 6 because of the informal use of the acronym "PRL." The Examiner indicated that the Applicants are required to spell out the acronym "PRL." Claim 6 does not include the acronym "PRL." However, the original claim 7 includes the acronym "PRL." Applicants have amended claim 7 to spell out the acronym "PRL" as preferred roaming list.

6. Conclusion

For the foregoing reasons, Applicants submit that claims 1-18 are in condition for allowance. Therefore, Applicants respectfully request favorable reconsideration and allowance of all of the claims.
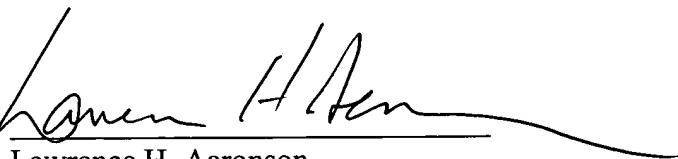
Respectfully submitted,

**MCDONNELL BOEHNEN
HULBERT & BERGHOFF**

Date: 8/20/04   By: _____
                            Lawrence H. Aaronson
                            Reg. No. 35,818